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Dickinson Wright PLLC
38525 Woodward Avenue
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EXAMINER

CHAMBERS, MICHAEL S

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

08/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,644

Applicant(s)

MONTANO ET AL.

Examiner

Mike Chambers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,3,10,18,21, and 22, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "stably rolling" is vague and indefinite. One of ordinary skill in the art would not be able to determine the metes and bounds of the term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by E-Lacrosse. E-Lacrosse discloses an open frame including a throat, a pair of sidewalls, and a transverse wall connecting said throat to each one of said pair of sidewalls;

said throat including two outer side surfaces, said throat intended to communicate with a lacrosse handle,

said each one of said pair of sidewalls having an inner surface and an outer surface as defined by a center line of said lacrosse handle

said outer surface of one of said pair of sidewalls and a respective outer side surface of said throat defining an outer surface structure,

said outer surface structure extending outward from a respective one of said two outer side surfaces of the throat and said one of said pair of sidewalls and connected by said transverse wall, wherein said outer surface structure is sized, shaped, and positioned for stably rolling a lacrosse ball along at least half of it's length (page 2 and 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17, 24,26 and 28 are rejected under 35 U.S.C. 103(a) as obvious over Hoult (3702702) and Official Notice. Official Notice is taken that it is well known in the art to utilize two solid sidewalls instead of one. It would have been obvious to one of ordinary skill in the art to have utilized two sidewalls in order to provide the player with a device that incorporates the current design for lacrosse heads. Also, it would have been obvious matter of design choice to a person of ordinary in the art at the time of the invention to have employed the lacrosse head of Hoult with a sidewall positioned for stably rolling a ball because the applicant has not disclosed this limitation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the cited prior art or the instant invention because both devices perform the same function. Therefore it

would have been an obvious matter of design choice to modify the cited art to include the instant invention as claimed.

As to claim 2: Hoult discloses an upper and lower arm and connecting portion (fig 2).

As to claims 3 and 4: Hoult discloses a connecting portion, which permits rolling a ball without contacting the connecting portion (fig 2). Although fig 2 would permit rolling a ball stably along the top of the lacrosse head, it would be a design choice to move this structure to the outer sidewall since the device would perform the same as before.

As to claim 5: Hoult discloses a length that is substantially at least half its entire length (fig 2).

As to claim 6: Hoult discloses upper and lower arms (fig 2).

As to claims 7-9, 11-13,14-16 : The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 10: Official Notice was taken that "current" lacrosse heads have two sidewalls.

As to claim 17: Hoult discloses a molded plastic head (fig 2, 2:13-16).

As to claim 24: Hoult discloses one or more projections (fig 3).

As to claim 26: Hoult discloses a semi-oval shape (fig 3).

As to claim 28: See claim 1 rejection. Hoult discloses a concave depression (fig 2).

Also,

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Claims 1-13, 17-23 and 28 are rejected under 35 U.S.C. 103(a) as obvious over Collinson (6213901). Collinson discloses an open frame including a throat, a pair of sidewalls, and a transverse wall connecting said throat to each one of said pair of sidewalls;

said throat including two outer side surfaces, said throat intended to communicate with a lacrosse handle,

said each one of said pair of sidewalls having an inner surface and an outer surface as defined by a center line of said lacrosse handle

said outer surface of one of said pair of sidewalls and a respective outer side surface of said throat defining an outer surface structure,

said outer surface structure extending outward from a respective one of said two outer side surfaces of the throat and said one of said pair of sidewalls and connected by said transverse wall, wherein said outer surface structure is sized, shaped, and positioned for stably rolling a lacrosse ball along at least half of its length (fig 1,2). Collinson does not clearly disclose the ability to "stably" roll a ball along at least half its length. It would have been obvious matter of design choice to a person of ordinary in the art at the time of the invention to have employed the lacrosse head with a sidewall positioned for stably rolling a ball because the applicant has not disclosed this limitation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the cited prior art or the instant invention because both devices perform the same function. Therefore it would have been an obvious matter of design choice to modify the cited art to include the claimed instant invention as claimed.

As to claim 2: Collinson discloses an upper and lower arm and connecting portion (fig 1,2).

As to claims 3 and 4: Collinson discloses a connecting portion which permit rolling a ball without contacting the connecting portion (fig 1,2).

As to claim 5: Collinson discloses a length that is substantially its entire length (fig 1,2).

As to claim 6 : Collinson discloses upper and lower arms (fig 1,2). The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claims 7-9: The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 10 : Collinson discloses bases and rails (fig 1,2).

As to claims 11-13 : The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent shapes based on the experience of the designer, or cost and design considerations.

As to claim 17 : Collinson discloses a molded plastic head (fig 2, 1:57-58).

As to claims 18-19: See claim 1 rejection.

As to claims 20-22: Collinson discloses a upper and lower arm and connecting portion that can roll a ball without contacting a connecting portion (fig 2). The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious

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to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 23 : See claim 1 rejection. The length limitation is a design choice. The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 28: See claim 1 rejection. Collinson discloses a concave depression (fig 1).

Also,

Claims 1-28 are rejected under 35 U.S.C. 103(a) as obvious over Morrow (6066056). Morrow discloses an open frame including a throat, a pair of sidewalls, and a transverse wall connecting said throat to each one of said pair of sidewalls;

said throat including two outer side surfaces, said throat intended to communicate with a lacrosse handle,

said each one of said pair of sidewalls having an inner surface and an outer surface as defined by a center line of said lacrosse handle

said outer surface of one of said pair of sidewalls and a respective outer side surface of said throat defining an outer surface structure,

said outer surface structure extending outward from a respective one of said two outer side surfaces of the throat and said one of said pair of sidewalls and connected by said transverse wall, wherein said outer surface structure is sized, shaped, and positioned for

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stably rolling a lacrosse ball along at least half of its length (fig 1,2). Morrow does not clearly disclose the ability to "stably" roll a ball along at least half its length. It would have been obvious matter of design choice to a person of ordinary in the art at the time of the invention to have employed the lacrosse head with a sidewall positioned for stably rolling a ball because the applicant has not disclosed this limitation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the cited prior art or the instant invention because both devices perform the same function. Therefore it would have been an obvious matter of design choice to modify the cited art to include the claimed instant invention as claimed (fig 2).

As to claim 2: Morrow discloses an upper and lower arm and connecting portion (fig 2).

As to claims 3 and 4: Morrow discloses a connecting portion which permit rolling a ball without contacting the connecting portion (fig 2).

As to claim 5: Morrow discloses a length that is substantially the entire length (fig 2).

As to claim 6: Morrow discloses upper and lower arms (fig 2). The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claims 7-9: The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 10 : Morrow discloses a bases and rails (fig 2).

As to claims 11-13 : The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent shapes based on the experience of the designer, or cost and design considerations.

As to claim 14 : Morrow discloses projections (fig 1,2 item 54).

As to claim 15 : Morrow discloses projections separated by a width less than the diameter of a lacrosse ball (fig 1,2 item 54).

As to claim 16 : Morrow discloses a semi-oval shape (fig 2,4).

As to claim 17 : Morrow discloses a molded plastic head (fig 2, 3:1-2).

As to claims 18-19, 24 : See claim 1 rejection.

As to claims 20-22: Morrow discloses a upper and lower arm and connecting portion that can roll a ball without contacting a connecting portion (fig 2,4). The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 23 : See claim 1 rejection. The length limitation is a design choice. The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 25: Morrow discloses projections separated by a width less than the diameter of a lacrosse ball (fig 1,2 item 54).

As to claim 26 : Morrow discloses a semi-oval shape(fig 2,4).

As to claim 27 : Morrow discloses a molded plastic head (fig 2, 3:1-2).

As to claim 28: See claim 1 rejection. Morrow discloses a concave depression (fig 1,2).

Also,

Claims 1-13,18-19 and 28 are rejected under 35 U.S.C. 103(a) as obvious over LeMire (20020107094). LeMire discloses an open frame including a throat, a pair of sidewalls, and a transverse wall connecting said throat to each one of said pair of sidewalls;

said throat including two outer side surfaces, said throat intended to communicate with a lacrosse handle,

said each one of said pair of sidewalls having an inner surface and an outer surface as defined by a center line of said lacrosse handle

said outer surface of one of said pair of sidewalls and a respective outer side surface of said throat defining an outer surface structure,

said outer surface structure extending outward from a respective one of said two outer side surfaces of the throat and said one of said pair of sidewalls and connected by said transverse wall, wherein said outer surface structure is sized, shaped, and positioned for stably rolling a lacrosse ball along at least half of it's length (fig 1,2). Morrow does not clearly disclose the ability to "stably" roll a ball along at least half its length. It would have been obvious matter of design choice to a person of ordinary in the art at the time of the invention to have employed the lacrosse head with a sidewall positioned for stably rolling a ball

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because the applicant has not disclosed this limitation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the cited prior art or the instant invention because both devices perform the same function. Therefore it would have been an obvious matter of design choice to modify the cited art to include the claimed instant invention as claimed (fig 2).

As to claim 2: LeMire discloses an upper and lower arm and connecting portion (fig 3b).

As to claims 3 and 4 : LeMire discloses a connecting portion which permit rolling a ball without contacting the connecting portion (fig 3b).

As to claim 5 : LeMire discloses a length that is substantially the entire length (fig 3b).

As to claim 6 : LeMire discloses upper and lower arms (fig 3b). The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claims 7-9, : The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 10: LeMire discloses a bases and rails (fig 3b).

As to claims 11-13 : The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill

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in the art to select any one of several equivalent shapes based on the experience of the designer, or cost and design considerations.

As to claims 18-19: See claim 1 rejection.

As to claim 28: See claim 1 rejection. LeMire discloses a concave depression having a shape of at least a portion of a ball (fig 3a,3b).

Claims 14-17, and 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMire as applied to claim 1 above, and further in view of Kohler et al (6916259). Kohler et al discloses the use of projections (fig 3). It would have been obvious to one of ordinary skill in the art to have utilized the projections of Kohler with the device of LeMire in order to provide a deeper pocket for those players who desire a deeper pocket and increase their satisfaction.

As to claim 15 : Kohler discloses projections separated by a width less than the diameter of a lacrosse ball (fig 3).

As to claim 16 : LeMire discloses a semi-oval shape (fig 2,3b).

As to claim 17 : LeMire discloses a molded plastic head (fig 1,3b,9:47-62).

As to claim 24 : See claim 14 rejection.

As to claims 20-22: LeMire discloses an upper and lower arm and connecting portion that can roll a ball without contacting a connecting portion (fig 2, 3b). The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

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As to claim 23 : See claim 1 rejection. The length limitation is a design choice. The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 25: Kohler discloses projections separated by a width less than the diameter of a lacrosse ball (fig 3).

As to claim 26 : Kohler discloses a polygon shape(fig 3).

As to claim 27 : LeMire discloses a molded plastic head (fig 1,3b,9:47-62).

Comments

The examiner regrets that there was a typographical error in the Advisory Action. The applicant had asked for a reconsideration of the claims and clarification as to whether of not the sidewall term used in the prior rejection was only directed to the sidewall. What the examiner was trying to say was that there was no distinction made in the rejection between the sidewall and all structures claimed on the outer portion of the open frame.

The applicant is directed to the following section of the MPEP and the recent KSR court decision concerning the skill of an ordinary skill in the art and what are obvious variations of existing art. The specification fails to disclose any surprising or unexpected result from the design modifications to a lacrosse head. Therefore these

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broad claims with little structural limitations are merely obvious design choices that would be obvious to one of ordinary skill in the art.

M.P.E.P. Section 2144.04

B. Changes in Shape

In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

Response to Arguments

Applicant's arguments filed 5/22/07 have been fully considered but they are not persuasive. The specification fails to disclose any surprising or unanticipated results for the instant invention. The existing claim language merely calls for a portion of the length of the sidewall to be sized and shaped to permit the rolling of any one of several sized balls along a portion of the sidewall. In theory, any molded area placed on the sidewall surface where any sized ball could be "stably" rolled, could broadly be read as infringing the instant invention. The specification provides no surprising or unanticipated results from the limitations claimed ; therefore they are considered a design choice and is not a patentable feature.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Chambers
Examiner
Art Unit 3711

August 8, 2007


EUGENE KIM
SUPERVISORY PATENT EXAMINER